

REMARKS

In the Office Action, the Examiner rejected claims 1-19, 21-24, and 26-86. By the present Response, Applicants amend claims 1, 4, 10, 11, 14, 15, 18, 29, 50, and 73-86 to further clarify the claimed subject matter, and cancel claim 3 without prejudice. Claims 20 and 25 were canceled in a previous communication. Upon entry of the amendments, claims 1, 2, 4-19, 21-24, and 26-86 will remain pending in the present patent application. Applicants respectfully request reconsideration of the above-referenced application in view of the foregoing amendments and the following remarks.

Claim Objections

In the Office Action, the Examiner objected to claim 73 for various informalities. Although Applicants do not necessarily agree with the Examiner's objections, Applicants amended claim 73, as set forth above, in the manner requested by the Examiner. Applicants also amended claims 74-86 to conform these dependent claims with the amendment to independent claim 73. In view of these amendments, Applicants believe the present objection is moot. Accordingly, Applicants respectfully request withdrawal of the objection to claim 73.

Rejections Under 35 U.S.C. § 112

In the Office Action, the Examiner rejected claims 74-86 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Examiner noted a clerical error with respect to these claims. Applicants thank the Examiner for noting this error, and have amended claims 74-86 as set forth above to clarify that these claims are directed to a computer program product in accordance with the subject matter recited in independent claim 73. In light of these amendments, Applicants respectfully request withdrawal of the rejection of claims 74-86 under 35 U.S.C. § 112.

Rejections Under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 1-5, 7-19, 21-24, 26-63, and 73-86 under 35 U.S.C. § 102(e) as anticipated by Dekel et al. (U.S. Patent No. 6,314,452). Applicants respectfully traverse this rejection.

Legal Precedent

Anticipation under Section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under Section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Moreover, the prior art reference also must show the *identical* invention “*in as complete detail as contained in the ... claim*” to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989) (emphasis added). Accordingly, Applicants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter.

Omitted Features of Independent Claims 1, 29, 50, and 73

Turning now to the present claims, the Dekel et al. reference fails to disclose each element of independent claims 1, 29, 50, and 73. For instance, independent claim 1 recites “requesting a data stream comprising the plurality of data sets arranged sequentially in a desired order based upon the lossless wavelet decomposition, *wherein the data sets form part of an image data file that is losslessly wavelet decomposed and that is stored in a losslessly compressed form on a server prior to receipt of a request from a client for data of the data sets*” (emphasis added). Applicants further note that independent claims 29, 50, and 73 each similarly recite “an image data file that is losslessly wavelet decomposed and that is stored in a losslessly compressed form on a server prior to receipt of a request from a client for data of the image sets.” Because the Dekel et al. reference fails to disclose such elements, the cited reference fails to anticipate the instant claims.

The Dekel et al. reference is generally directed to the transmission of static images over communication channels. Col. 1, lines 8-14. The Dekel et al. system includes a client computer 110 for receiving image data and a server 120 for transmitting image data, which are connected to each other via communication network 130. Col. 3, line 66 – col. 4, line 16; FIG. 1. The apparatus is configured to allow client 110 to select a region of interest (ROI) with respect to a particular set of image data and to formulate the region of interest into a request list corresponding to particular data blocks addressed by position and resolution within the larger set of data. Col. 4, lines 62-65; *see also* col. 5, lines 25-37. Notably, the Dekel et al. reference teaches the storage of *uncompressed* digital images on server 120. *See, e.g.*, col. 22, lines 38-41. The server 120 receives a request for the image from client 110 and performs a preprocessing step 801. Col. 22, lines 49-51. After this preprocessing step 801, the server 120 can transmit data requested by the client 110. Col. 22, line 53 – col. 23, line 6.

Conversely, as noted above, the present independent claims generally recite “an image data file that is losslessly wavelet decomposed and that is *stored in a losslessly compressed form* on a server prior to receipt of a request from a client for data” (emphasis added) of the data or image sets. Because the cited reference clearly teaches storing images in an *uncompressed* form on a server, and, in fact, teaches away from storing compressed images, the Dekel et al. reference cannot be reasonably considered to disclose the *compressed* image data file of the present claims. Further, as the cited reference fails to teach storage of a compressed image on a server prior to a client request, the reference necessarily fails to disclose a losslessly compressed image data file stored on a server prior to a client request. Because the cited reference fails to teach each and every element of the present claims, the Dekel et al. reference cannot anticipate independent claims 1, 29, 50, and 73, or the claims depending therefrom.

For at least these reasons, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 102 and allowance of claims 1, 2, 4, 5, 7-19, 21-24, 26-63, and 73-86.

Rejections Under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claim 6 under 35 U.S.C. § 103(a) as unpatentable over Dekel in view of Sodagar et al. (U.S. Patent No. 6,157,746). The Examiner also rejected claims 64-72 as being unpatentable over Dekel in view of Cooke, Jr. et al. (US Patent No. 6,574,629). Applicants respectfully traverse these rejections.

Legal Precedent

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988).

Deficiencies of the Rejections

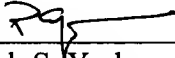
Applicants note that each of claims 6 and 64-72 depends from one of independent claims 1 or 50. As discussed above, the Dekel et al. reference fails to disclose each element of independent claims 1 and 50. Further, neither the Sodagar et al. reference nor the Cooke, Jr. et al. reference obviates the deficiencies of the Dekel et al. reference. As a result, dependent claims 6 and 64-72 are allowable on the basis of their dependency from a respective allowable independent claim, as well as for the subject matter separately recited in these dependent claims. Accordingly, Applicants respectfully request withdrawal of the Examiner's rejection and allowance of claims 6 and 64-72.

Conclusion

In view of the remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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